

Regarding claim 10, the Examiner states that “Ihata further teaches an apparatus for transmitting call back number after call goes on-hook, the apparatus comprising: storage means (6, fig. 1) for storing the callback number upon initiation of a call, transmitting means (5, fig. 1) coupled to the storage means for transmitting stored callback number upon detecting an on-hook event (fig. 1, see abstract).”

Regarding claims 2, 7, 9, 11, 16, 18, the Examiner states that “Ihata further teaches the following: step of disconnecting the call after the step of transmitting (this is implied by on-hook state of the caller telephone), transmitting over the private network and/or public network is accomplished via DTMF signaling, disconnect means (reads on 2, fig. 1) for disconnecting the call after transmitting means transmits the stored callback number, transmitting means includes means (5, fig. 1) for DTMF signaling, disconnect means (reads on 2, fig. 1) includes means (implicit) for sending a trunk release (fig. 1, see abstract).”

According to the Examiner, “Ihata differs from the claimed invention by not teaching storing ELIN number relating to emergency call and transmitting it.”

However, according to the Examiner, “Hoskinson discloses emergency response system which teaches the following: storing ELIN number relating to an emergency call and transmitting it (col. 6 lines 46-65).”

It is the Examiner’s position that “it would have been obvious to one of ordinary skill in the art at the time invention was made to modify Ihata’s system to provide for the following: storing ELIN number relating to emergency call and transmitting it as this arrangement would enable transmitting ELIN number in connection with an emergency call as taught by Hoskinson, thus providing enhancements to the application capability of Ihata’s system.”

It is respectfully submitted that the Examiner’s rejection is incorrect for two reasons. First, the Ihata reference does not teach what the Examiner says it does. Second, there is no incentive to combine the references.

The present invention enables the transmission of ELIN data to an emergency response center even if the caller hangs up before the data would normally be sent. The present invention does this by storing ELIN data in a buffer when an emergency call is initiated and transmitting the data from the buffer when an on-hook condition is detected as set out in claim 1. As set forth in claim 2, the emergency call can be disconnected after the transmission.

*no automatic transmission*

The Ihata reference does not concern emergency calls. Ihata teaches a system where a collect call is made from a first phone to a second phone. A device sends a message to the caller requesting a call back number. The caller enters his call back number using the DTMF keypad and hangs up. When the caller hangs up, the device at the second phone calls the first phone using the number supplied by the caller. There is no automatic transmission of call back information. In fact, the call back number must be manually entered. The call back information is not transmitted as described in the present invention. Although the English translation of the Japanese abstract uses the word transmitted, what is really meant is that the call back number is dialed. This is clear from reading the remainder of the sentence. Even if it were transmitted, it would be transmitted back to the caller not from the caller, which would have been arguably analogous to the present invention. The only transmission of call back data from the caller in Ihata is performed manually when the caller enters his phone number with the DTMF keypad.

Before discussing the teachings of Hoskinson and the likelihood of making a combination with Ihata, it is respectfully pointed out that the Examiner's stated incentive to combine the references does not satisfy the requirements for a complete rejection.

MPEP 706.02(j) "Contents of a 35 U.S.C. 103 Rejection" provides as follows:

"35 U.S.C. 103 authorizes a rejection where, to meet the claim, it is necessary to modify a single reference or to combine it with one or more other references. After indicating that the rejection is under 35 U.S.C. 103, the examiner should set forth in the Office action:

(A) the relevant teachings of the prior art relied upon, preferably with reference to the relevant column or page number(s) and line number(s) where appropriate,

- (B) the difference or differences in the claim over the applied reference(s),
- (C) the proposed modification of the applied reference(s) necessary to arrive at the claimed subject matter, and
- (D) an **explanation** why one of ordinary skill in the art at the time the invention was made would have been motivated to make the proposed modification.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some **suggestion or motivation**, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest **all the claim limitations**. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP § 2143 - §2143.03 for decisions pertinent to each of these criteria.

The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest **the claimed invention** or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." Ex parte Clapp, 227 USPQ 972, 973 (Bd.Pat. App. & Inter. 1985). See MPEP § 2144 - § 2144.09 for examples of reasoning supporting obviousness rejections.

Where a reference is relied on to support a rejection, whether or not in a minor capacity, that reference should be positively included in the statement of the rejection. See In re Hoch, 428 F.2d 1341, 1342 n.3 166 USPQ 406, 407 n. 3 (CCPA 1970).

It is important for an examiner to properly communicate the basis for a rejection so that the issues can be identified early and the applicant can be given fair opportunity to reply. Furthermore, if an initially rejected application issues as a patent, the rationale behind an earlier rejection may be important in interpreting the scope of the patent claims. Since issued patents are presumed valid (35

U.S.C. 282) and constitute a property right (35 U.S.C. 261), the written record must be clear as to the basis for the grant.

Since patent examiners cannot normally be compelled to testify in legal proceedings regarding their mental processes (see MPEP § 1701.01), it is important that the written record clearly explain the rationale for decisions made during prosecution of the application. See MPEP § 2141 - § 2144.09 generally for guidance on patentability determinations under 35 U.S.C. 103, including a discussion of the requirements of Graham v. John Deere, 383 U.S. 1, 148 USPQ 459 (1966). See MPEP § 2145 for consideration of applicant's rebuttal arguments. See MPEP § 706.02(l) -§ 706.02(l)(3) for a discussion of prior art disqualified under 35 U.S.C. 103(c)." [Emphasis added.]

"The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference.... Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art."

In re Keller, 202 U.S.P.Q. 500 (C.C.P.A. 1979). See, also, ACS Hospital Sys., Inc. v. Montefiore Hospital, 221 U.S.P.Q. 929 (Fed. Cir. 1984). "Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined only if there is some suggestion or incentive to do so."

Without providing evidence of incentive to combine, it is respectfully submitted that the combination of references is based on hindsight. To draw on hindsight knowledge of the applicant's specification, when the prior art does not contain or suggest the knowledge, is to use the invention as a template for its own reconstruction--an illogical and inappropriate process in which to determine patentability. In In re Dembiczak, 50 USPQ2d 1614, (Fed. Cir. 1999), the Federal Circuit noted that

"[m]easuring a claimed invention against the standard established by section 103 requires the oft-difficult but critical step of casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. . . . Close adherence to this methodology is especially important in the case of less technologically complex inventions, where the very ease with which the invention can be understood may prompt one "to fall victim to the insidious effect of a

*motivation* hindsight syndrome wherein that which only the inventor taught is used against its teacher." Id. at 1617

*blueprint* The simplicity of the invention does not remove the Examiner's duty of providing evidence of a teaching or motivation. "Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability--the essence of hindsight." Id.

The Examiner's stated incentive for combining Ihata with Hoskinson is that it would provide "enhancements to the application capability of Ihata's system." It is respectfully submitted that this incentive does not exist and, even if it did, would not lead one to make the combination suggested by the Examiner. The Examiner must say where the prior art provides the incentive, but there is no indication in the record to show where the prior art suggests enhancing the system of Ihata. Further, even if there were some reference to suggest that the Ihata system should be "enhanced" that does not amount to a suggestion that the enhancement be made by combining it with Hoskinson.

Simply put, there is no incentive to combine these references because they are directed to two completely different problems. While Hoskinson is involved with the transmission of ELIN information, as is the present invention, Ihata is not concerned with ELIN data nor is Ihata concerned with emergency response. The sole purpose of Ihata is to provide a call back to a collect caller. This is presumably because the toll rate of the call back is lower than the toll rate of the collect call.

Claims 3 and 12 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Ihata in view of Hoskinson as applied to claims 1 and 10 above, and further in view of Sato et al. (JP410051553A, hereinafter Sato). This rejection is respectfully traversed.

The Examiner states that "the combination [of these references] does not teach the following: prior to the step of transmitting, initiating a timer, wherein the step of disconnecting is performed after the timer expires."

According to the Examiner, "Sato discloses communication equipment which teaches the following: prior to the step of transmitting, initiating a timer (133, fig. 1), wherein the step of disconnecting is performed after the timer expires."

Thus, it is the Examiner's contention that "it would have been obvious to one of ordinary skill in the art at the time invention was made to modify the combination to provide for the following: prior to the step of transmitting, initiating a timer, wherein the step of disconnecting is performed after the timer expires as this arrangement would provide means to prevent useless occupation of subscriber's line as taught by Sato."

It is respectfully submitted that this rejection must fail for the same reasons as discussed above with regard to combining Ihata and Hoskinson and the lack of teaching in Ihata. Moreover, the stated incentive for combining Sato with Ihata and Hoskinson is irrelevant to the present invention and is also inapt to Ihata and Hoskinson.

Applicant admits that Applicant finds it difficult to understand exactly what problem the Sato disclosure addresses. Nevertheless, the prevention of useless occupation of the subscriber's line is not an issue in the present invention, nor is it an issue in Ihata or Hoskinson. The present invention prevents a disconnection after an emergency caller hangs up so that ELIN data can be sent. A timer may be used to delay the disconnection until the information is transmitted. This is quite the opposite of the intention of Sato. If Sato is to be understood, a timer is used to hasten the disconnection so the line is not kept occupied. In the present invention, a timer would be used to delay the disconnection.

Claims 4, 6, 13, and 15 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Ihata in view of Hoskinson as applied to claims 1 and 10 above, and further in view of Matsuura (JP410210171A). This rejection is respectfully traversed.

The Examiner states that "the combination [of the references] does not teach the following: step of transmitting to the public network is accomplished via ISDN SETUP message, step of disconnecting is accomplished via an ISDN DISCONNECT message."

However, according to the Examiner, "Matsuura discloses ISDN data terminal equipment which teaches the following: step of transmitting to the public network is accomplished via ISDN SETUP message, step of disconnecting is accomplished via an ISDN DISCONNECT message (fig. 1, see abstract)."

It is the Examiner's position that "it would have been obvious to one of ordinary skill in the art at the time invention was made to modify the combination to provide for the following: step of transmitting to the public network is accomplished via ISDN SETUP message, step of disconnecting is accomplished via an ISDN DISCONNECT message as these are well known protocols in ISDN system to be provided for, thus enhancing the application capability of the combination."

It is respectfully submitted that this rejection fails for all of the reasons stated above regarding the improper combination of the references and also because there is no incentive to combine Matsuura with the other references. The Examiner's stated incentive "enhancing the application capability of the combination" is not present in the art and is ambiguous. The Examiner has not pointed out where it is suggested in the prior art that the imagined combination of Ihata and Hoskinson should be "enhanced", nor has he pointed out where it is suggested that such an enhancement be related to ISDN signaling.

Claims 5 and 14 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Ihata in view of Hoskinson as applied to claims 1 and 10 above, and further in view of Israelsson (US PAT: 6,301,483 B1, filed 11-10-1998). This rejection is respectfully traversed.

The Examiner states that "the combination [of the references] does not teach the following: transmitting is accomplished over a private network via QSIG ISDN SETUP message signaling."

It is the Examiner's position that "Israelsson discloses device network and methods concerning cordless communication which teaches the following: transmitting is accomplished over a private network via QSIG ISDN SETUP message signaling (col. 7 lines 29-32)."

According to the Examiner, "it would have been obvious to one of ordinary skill in the art at the time invention was made to modify the combination to provide for the following: transmitting is accomplished over a private network via QSIG ISDN SETUP message signaling as these are well known protocols used in the communication system and provide for, thus enhancing the application capability of the combination."

It is respectfully submitted that "enhancing the application capability of the combination" is not an incentive to make any particular combination and thus falls short of the required incentive necessary to make an obviousness rejection. Even if this were an incentive, it is not found anywhere in the art of record. The Examiner has not shown where one would find this incentive.

Claims 8 and 17 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Ihata in view of Hoskinson as applied to claims 1 and 10 above, and further in view of Tanaka et al. (US PAT: 6,243,442B1, filed 12-19-1997, hereinafter Tanaka). This rejection is respectfully traversed.

The Examiner states that "the combination [of the references] does not teach the following: transmitting is accomplished via CAMA trunk type signaling."

However, the Examiner states that "Tanaka discloses telephone exchange apparatus which teaches the following: transmitting is accomplished via CAMA trunk type signaling (col. 8 lines 66-67, col. 9 lines 1-14)."

According to the Examiner, "it would have been obvious to one of ordinary skill in the art at the time invention was made to modify the combination to provide for the following:

transmitting is accomplished via CAMA trunk type signaling as this arrangement would provide redundancy for transmitting emergency calls as taught by Tanaka."

It is respectfully submitted that this rejection fails for the reasons stated above with regard to Ihata and Hoskinson. In addition, the stated incentive to "provide redundancy" is not taught by Tanaka. Tanaka would seem to avoid redundancy. See, e.g. col. 3, lines 21-26 of Tanaka: "The present invention has been made to solve problems mentioned above and intends to provide a telephone exchange apparatus capable of conveniently executing an emergency call to a line corresponding to the Enhanced 911 call. Moreover, it avoids the redundancy of providing double MF signal source."

In conclusion, therefore, it is submitted that the Examiner has not made out a *prima facie* case for obviousness and that the claims are therefore allowable over the art of record.

In view of the foregoing, it is respectfully requested that the claims as originally submitted be reconsidered and that the rejections of record be withdrawn.

It is respectfully submitted that all claims of record are in condition for allowance. Reconsideration and allowance at an early date is respectfully requested.

Respectfully submitted,

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VERSION OF SPECIFICATION PARAGRAPHS WITH  
MARKINGS SHOWING CHANGES MADE

This application is related to co-owned co-pending application Serial Number 09/816,843 entitled “Methods and Apparatus For Transmitting Accurate Emergency Location Identification Numbers (ELINs) From Behind A Multiline Telephone System (MLTS) Utilizing Port Equipment Numbers”; co-owned co-pending application Serial Number 09/816,627 entitled “Priority Based Methods And Apparatus For Transmitting Accurate Emergency Location Identification Numbers (ELINs) From Behind A Multiline Telephone System (MLTS)”; co-owned co-pending application Serial Number 09/816,830 entitled “Methods and Apparatus For Transmitting Over A Private Network Accurate Emergency Location Identification Numbers (ELINs) From Behind A Multiline Telephone System (MLTS) Utilizing Port Equipment Numbers”; co-owned co-pending application Serial Number 09/816,823 entitled “Methods And Apparatus For Transmitting Accurate Emergency Location Identification Number (ELINs) From Behind A Multi-Line Telephone System (MLTS) After An Emergency Caller Disconnects”; co-owned co-pending application Serial Number 09/815,685 entitled “Methods and Apparatus For Dialing An Emergency Telephone Number From A Teleworking Client Remotely Coupled To A PBX”; and co-owned co-pending application Serial Number 09/815,468 entitled “System For Dialing An Emergency Telephone Number From A Teleworking Client Remotely Coupled To A PBX”, the complete disclosures of which are hereby incorporated by reference.